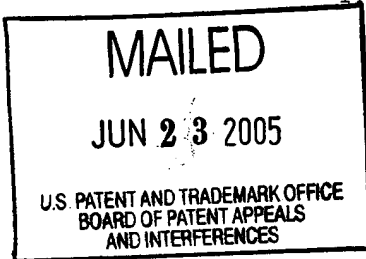


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD COVANNON, DAVID L. PATTON,
THOMAS M. STEPHANY and KATHRYN K. NASS



Appeal No. 2005-0946
Application No. 09/915,448

ON BRIEF

Before THOMAS, DIXON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 47-72¹, which are all of the claims pending in this application.

¹ We observe that claim 62 depends from claim 1, which has been canceled. We presume that claim 62 depends from claim 47, as claim 51 depends from claim 47 and contains language similar to claim 62. We consider this a formal matter to be addressed by the examiner and appellants subsequent to the appeal.

BACKGROUND

Appellants' invention relates to an intelligent toy with Internet connection capability. An understanding of the invention can be derived from a reading of exemplary claim 47, which is reproduced as follows:

47. A system for controlling the operation of an interactive device in accordance with a user's personal profile, comprising:

an interactive device designed to provide self-generating interaction with one or more users, said interactive device having information obtaining means for independently obtaining the identity of said one or more users and for determining at least one aspect of the local environment in which said interactive device is located at the time of operation of said interactive device; and

a computer for providing instructions to said interactive device for controlling the operation of said interactive device in response to a stored personal profile of said one or more users and said at least one aspect the local environment.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Gershman et al. (Gershman) 6,401,085 June 4, 2002
(filed: Mar. 5, 1999)

Claims 47-72 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Gershman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections,

we make reference to the examiner's answer (mailed July 13, 2004) for the examiner's complete reasoning in support of the rejections, and to appellants' brief (filed May 10, 2004) and reply brief (filed September 1, 2004) for appellants' arguments thereagainst. Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we affirm-in-part. We begin with independent claim 47.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or

inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgird v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939))

(internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Appellants assert (brief, page 3) that:

The independent claims specifically set forth that the interactive device is designed to provide self generating interaction with one or more users. What this means is that the device itself, on its own initiative personal profiles and programs, will provide certain actions with respect to the current user. For example, if the interactive device is a toy, and the toy knows that it is near a store, the device could say "would you like to go shopping" without any input or question provided by the user. There is no need to provide user input into the device.

It is argued that Gershman is simply a PDA that provides responses to inputs by a user, and (brief, page 4) that Gershman:

is not an interactive device designed to produce self-generating action on its own initiative. The reactive theme is set forth in numerous places in Gershman et al. for example, in the field of the invention Gershman states that the invention is directed to agent-based system and more particularly to a mobile computing

environment that accesses the internet to obtain product information for a user and provides tools for collaborative computing.

Appellants add (id.) that:

It can be clearly seen that the device of Gershman reference is not an interactive self generating device to which the present invention is directed, but instead is directed to a general all purpose device that provides information in response to requests.

Appellants further assert (id.) that "[t]he independent claims of the present claims also set forth means for independently obtaining the identity of one or more users." It is additionally argued (brief, pages 4 and 5) that:

The Gershman reference fails to disclose:

1. providing interactive device;
2. providing self generating interaction with the user;
3. providing independent means for obtaining the identity of the user;
4. providing a computer for controlling the operation of the interactive device in response to the stored personal profile of the user and at least one aspect of the local environment.

The examiner's position (answer, pages 3-5) is a general discussion of Gershman and does not refer to any particular claim by claim number. Nor does the examiner provide a one-to-one correspondence for any of the claims. In the remarks, the only argument answered by the examiner is the argument that Gershman does not provide "self generating" interaction with one or more

users. The examiner asserts (answer, pages 5 and 6) that the limitation in question represents the "main thrust" of appellants' argument. According to the examiner, this limitation is met by the Electronic Valet 2602. The examiner gives the example of when an integrated bio-sensor obtains certain predefined data values, an appropriate emergency care provider would be automatically contacted. In addition, data obtained from sensors, GPS, camera, microphones and other user inputs 2600, may also be combined before being sent to the appropriate service provider. For example, GPS position data may be sent with the bio-sensor data to the emergency care provider, so that the emergency care provider would know the patient's biological data and the patient's location, so service could be provided.

Appellants respond (reply brief, page 2) that column 61 of Gershman discloses a situation in which the PDA may automatically send to selected services information based on a biosensor. It is argued that this is not the same as an interactive device, and that the system of Gershman is nothing more than an alarm system, that is common in hospitals.

From our review of Gershman, we find that Gershman is directed to a system that facilitates a web-based information and retrieval system. A wireless phone or similar device with

Internet capability is combined with other peripherals to provide a portable portal into the Internet. The wireless device prompts a user to input information of interest to the user. The information is transmitted to a service routine which queries the Web to find price, shipping and available information from various Web suppliers. This information is formatted and displayed on the hand-held device's screen. The user may then use the device to place an order interactively (col. 3, lines 14-25).

As shown in figure 17, consumer access devices can include television, mobile telephones, computers, smart cards, laptop computers, pocket organizers, vehicles and PDAs. Gershman further discloses that an agent keeps statistics for each user, and that these statistics are used in a manner similar to the Tamagochi's virtual reality pet toy to encourage behaviors from the user. The statistics recorded are frequency of login, frequency of rating contents such as news articles, and activity of agents, measured by the number of tasks they perform in a certain period (col. 41, lines 53-61). Figure 17 discloses the detailed logic associated with accessing the user's centrally stored profile. Consumers can gain access to services from devices such as their television, mobile phones, smart cards, gas

meters, water meters, kitchen appliances, security systems, PDAs, etc. (col. 43, lines 61-63 and col. 44, lines 6-9.

Figure 20 illustrates a display login implemented with an agent 2000 that guides the user through the process of interacting with the system to customize and personalize various system components to gather information and interact with the user's personal requirements (col. 45, lines 36-42). From the disclosure of Gershman that, as shown in figure 20, the system's PDA interacts with the user, we find the PDA of Gershman's system to be an interactive device. We consider the term "interactive," as it would be understood by an artisan, to refer to the back-and-forth dialog between the user and the computer². We find no definition of the term in appellant's specification that would preclude the term from being defined as set forth, supra.

The Intelligent Agent Coordinator 2580 of figure 25 is also the user's interface to the system. The Intelligent Agent coordinator has four primary responsibilities:

- 1) monitoring user activities,
- 2) handling information requests,
- 3) maintaining each user's profile, and
- 4) routing information to and from users and to and from the other respective agents. (Gershman, col. 47, lines 47-51).

² TechWeb TechEncyclopedia, ©1981-2005 the Computer Language Company. A copy of the definition is enclosed with the Decision.

Anytime a user triggers a sensor, the Intelligent Agent Coordinator receives an "environmental cue." It is further disclosed (col. 47, lines 53-61) that "[t]hese cues not only enable the Intelligent Agent Coordinator to gain an understanding where users are for information delivery purposes, but also learn the standard patterns (arrival time, departure time, etc.) of each person's life. These patterns are constantly updated and refined to increase the system's intelligence when delivering information." The Intelligent Agent Coordinator also tries to determine where each user is physically located throughout the day for routing purposes (col. 48, lines 28-31). As an example, if a user were at her desk using the web client, the Intelligent Agent Coordinator would know to send any necessary information to her PC. As an alternative, if the Intelligent Agent Coordinator had just received an indication (via the key card reader next to the exit) that the person had left the building, and minutes later an urgent message is received, the Intelligent Agent Coordinator, knowing the person has left the building, will send the text of the urgent message to the hand held device (col. 48, lines 40-44 and 46-56).

From the disclosure that the system will recognize that a person has left the building and send an urgent message to the

person's PDA instead of their PC, we find that the interactive device of Gershman provides self-generating interaction with the user.

Gershman further discloses an Electronic Valet in the form of a hand held wireless computer. Integrated into the electronic Valet are various sensors, such as GPS, Bio-Sensors, and Environ-Sensors (col. 60, lines 50-55). The Electronic Valet 2602 receives input data from sensors, GPS, camera, microphone, and other user inputs 2600 integrated with the hand held wireless device, as shown in figure 26 (col. 60, lines 61-65). With the Electronic Valet, the user may select a service to use in concert with appropriate data obtained from sensors, GPS, etc. For example, when an integrated bio sensor obtains certain predefined data values, an appropriate emergency care person would be automatically contacted. In addition, GPS position data may be sent with the bio-sensor data to the emergency care provider, so that the emergency care provider would then know the patient's biological data and the location of the patient, so that appropriate service could be provided (col. 61, lines 34-51).

From the disclosure of Gershman, we find that when the bio-sensors obtain certain predefined data values, the emergency care provider is provided with the patient's biological data as well

as the patient's location. From the disclosure of using GPS to track the patients location, we find a teaching of determining at least one aspect of the local environment (location). From this disclosure and the additional disclosure (col. 68, line 46 through col. 70, line 10) that the bio-sensors include Pressure Transducers, Volumetric Sensors, Defibrillator, respiratory sensors such as strain gauges, etc., we find that Gershman discloses information obtaining means for obtaining information with respect to the user. Moreover, from the disclosure of Gershman (col. 70, lines 2-4) of utilizing the integrated defibrillator, we find a teaching of the system providing instructions to the interactive device (i.e., the PDA with integrated Defibrillator), for controlling the operation of the interactive device (i.e., operating the defibrillator).

However, we find no disclosure, and the examiner has not pointed to any disclosure, of independently obtaining the identity of the user. We are cognizant of the fact that the patient, in need of medical assistance, is identified to the emergency care provider along with the patient's biometrics and location. However, claim 47 requires independently obtaining the identity of the user, not transmitting the identity of the user. Although the emergency service provider will determine the

identity of the user without any input from the user him/her self, the claim requires that it is the interactive device that has information obtaining means for independently obtaining the identity of the user. In Gershman, the PDA is already aware of who the user is, and is measuring the user's biometrics.

From all of the above, we find that the examiner has failed to establish a prima facie case of anticipation of claim 47. Accordingly, the rejection of claim 47 under 35 U.S.C. § 102(e) as being anticipated by Gershman is reversed. As claims 48-64 depend from claim 47, the rejection of claims 48-64 under 35 U.S.C. § 102(e) is reversed.

Turning to independent claims 65 and 69, we reach, for the reasons which follow, the opposite conclusion. Notwithstanding appellants' assertion (brief, page 4) that "[t]he independent claims of the present claims also set forth means for independently obtaining the identity of one or more users " (underlining added), we find that this limitation is not found in either claim. Appellants have not provided any arguments for these claims, but rather set forth (brief, page 2) that these claims stand or fall with claim 47. Thus, as to these claims, we consider appellants' arguments to the extent that the limitations argued for claim 47 apply to claims 65 and 69. Based upon our

findings, supra, with respect to the rejection of claim 47, we will sustain the rejection of claims 65 and 69 because neither claim recites independently obtaining the identity of the user, but rather that the interactive device obtains data with respect to the user. As set forth, supra, this language, as broadly recited in claims 65 and 69, is met by Gershman. Accordingly, the rejection of claims 65 and 69 is affirmed. As claims 66-68 and 70-72 depend from claims 65 and 69, and have not been argued by appellants, claims 66-68 and 70-72 fall with claims 65 and 69.

To summarize, the decision of the examiner to reject claims 47-64 under 35 U.S.C. § 102(e) is reversed. The decision of the examiner to reject claims 65-72 under 35 U.S.C. § 102(e) is affirmed.

AFFIRMED-IN-PART

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